UNITED STATES PATENT AND TRADEMARK OFFICE

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08/924,785	09/05/1997	RICHARD W. PRATT	.785	4422

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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 08/924,785
Filing Date: September 05, 1997
Appellant(s): PRATT, RICHARD W.

MAILED

DEC 1 6 2004

Technology Center 2100

David B. Ritchie (Reg. No. 31,562)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/26/04.

(1)   *Real Party in Interest*

A statement identifying the real party of interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4)   *Status of Amendments*

The appellant's statement of the status of amendments contained in the brief is correct.

(5)   *Summary of the Invention*

The summary of the invention contained in the brief is correct.

(6)   *Issues*

The appellant's statement of the issues in the brief is correct.

(7)   *Grouping of Claims*

Appellant's brief includes a statement that claims of the following groups of claims stand or fall together and proved reasons as set forth in 37 CFR 1.192 (c) (7) and (c) (8).

Group I: Claims 44, 62-64 and 67-74 stand or fall together.

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix A to the brief is correct.

(9) *Prior art of record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Madany	U.S. Patent No. 5,922,050	07-1999
Beard	U.S. Patent No. 6,067,577	05-2000
Nakagawa et. al.	U.S. Patent No. 5,835,911	11-1998

(10) *Grounds of Rejection*

1.   The following is quotation of 35 U.S.C. §103(a), which forms the basis for all obviousness rejection, set forth in this Office action:

> (a) A patent may be not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art of record are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 44, 62-64 and 67-74 are rejected under 35 U.S.C. §103(a) as being unpatentable over Madany U.S. Patent No. 5,922,050 in view of Beard U.S. Patent No. 5,875,335 in further view of Nakagawa et. al. (Nakagawa) U.S. Patent No. 5,835,911.

Regarding claim 44, a method comprising:

obtaining a ("new downloadable unit") program (Madany: col 8/lines 4-41, col 1/lines 60-col 2/line 3) for performing a function ("new service") (Madany: col 5/lines 44-49), the program including

a component ("communicator component") for establishing a communication across communication channel (14) between the client device (10) and the software program (Madany: col 4/lines 19-31, col 5/lines 31-43) included in the network device;

a component ("interface component") for enabling the client device to communicate with software program within the network device (Madany: col 5/lines 31-43, col 4/line 24-28);

a component ("configuration") for controlling (managing) the network device (Madany: col 4/lines 41-48 and col 7/lines 56-58); however Madany does not explicitly teach a program contained (embedded) in a compiled software program file, and retrieving the embedded program from the compiled software program file;

Beard teaches a remote client device (12) receiving a program (e.g. applet) from a server (10) over the network (18) (col 3/lines 46-67);

a program or method ("the downloadable unit") is embedded in the compiled (binary) file of the operating system (software program), i.e. functions or methods within (embedded) the compiled code (i.e. binary form) of the operating system file (26) (software program), such as function services (library) are contained in a compiled code of the operating system program file (col 2/lines 28-32), these are identified by a particular package of classes (downloadable unit) (col 2/lines 56-63); wherein the libraries to be extracted for a class are embedded in the package for the class (col 5/lines 66-col 6/line 1);

embedded downloadable unit from the binary file, i.e. the functions library services (programs) within (embedded) the compiled code (i.e. binary form) of the operating system file (26) (software program) (col 2/lines 28-32).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include a program(s) contained (embedded) in a compiled software program file, transferable over the Internet including means for extracting the embedded program from the compiled software program file to be used by an application, wherein the programs are configured as downloadable units, applets or embedded package of classes embedded in the compiled code of the operating system file, as taught by Beard, motivation to combine these teachings to configure embedded downloadable units, class packages or applets with dynamic linked libraries containing all information necessary to configure or define, control and communicate remotely with any device containing hardware/software resource. However neither the teachings of Madany nor Beard teach the substitution of program onto a network device;

Nakagawa teaches a system/method related to software distribution/maintenance with which a software distributors can provide and update for a number of users software/services over a network, for systematically distributed/maintained, re-installing and upgrading via a network connecting many distributor and users of client/server software, wherein a client program automatically updates the software to the latest version according to the update instruction information when it is received (Nakagawa: col 1/line 13-col 5/line 10, abstract), disclosing means for extracting software from a network device (computer 11 of Fig. 2) and replacing with updated software (Nakagawa: col 22/lines 35-62);

It would be obvious to one ordinary skilled in the art at the time the invention was made to combine teachings of existing system with means for retrieving the network device control software program binary file having an embedded old downloadable unit for performing an old service from a network device, as taught by Nakagawa, motivation would be to further enhance existing means for adding, upgrading services to include a software distribution and maintenance means obtainable over a

network for other various types of software such as product software, shareware, embedded software, freeware, scientific prototype software, intra-office software, etc, in an immediately operable form.

Regarding claim 62, this claim is the computer readable medium having stored thereon computer readable instructions for performing the method claim discussed above, same rationale of rejection is applicable.

Regarding claim 63, this claim is the computer-readable medium having stored thereon computer-executable instructions for performing the method disclosed on claim 44, same rationale of rejection is applicable.

Regarding claim 64, the network device includes a router (Madany: col 3/lines 41-43).

Regarding claim 67, downloadable unit includes more than one unit (Beard: col 2/lines 56-67).

Regarding claim 68, downloadable units are combined into bundles (Beard: col 5/lines 66-col 6/line 4, and col 5/lines 21-30).

Regarding claim 69, downloadable units are combined into bundles according to a function (Beard: col 2/lines 56-67).

Regarding claim 70, downloadable units are combined into bundles according to a version information (Beard: col 2/lines 56-67).

Regarding claims 71-72, the program includes an operating system (Beard: col 4/lines 57-col 5/line 5) and network device includes a router (Madany: col 3/lines 41-43).

Regarding claim 73, the program includes services ("list of available management services") (Beard: col 4/lines 57-col 5/line 5).

Regarding claim 74, downloadable unit include services (Beard: col 4/lines 57-col 5/line 5).

(11)   Response to Arguments

A. The following arguments are NOT found to be directed to the claimed invention, specifically, the claim language or limitations.

3.   Appellant argues (p. 8), the Madany reference achieves low cost by reducing the processing hardware and software to the base minimum given disclosure on column 1, line 11 to column 2, line 7.

In response to the above argument, Appellant's interpretation has been considered, and the provided passage has been reviewed, however the is no explicit or implicit recitation or evidence of this in the provided citation of column 1, line 11 through column 2, line 7.

4.   Appellant argues (p. 9), the Madany reference, the consumer already has or is willing to buy at least one high cost device to realize the system.

In response to the above argument, Appellant's interpretation has been considered, and the provided passage has been reviewed. However, the underlying assumption as construed by Appellant is not supported by an explicit or implicit recitation or evidence of this in the provided citation of column 2, lines 10-23.

5. ·   Appellant argues (p. 10), the Madany reference, predominantly, the devices and computer are described independently of one another. On column 3, line 45, further according to Appellant, the Madany reference lists a computer as being a possible example of a device, this is characterized by Appellant as "unusual as it is out of place with the other examples, which include light switches, television, radios, door locks, telephones, coffee makers, security systems, and VCRs". Thereby, According to Appellant one ordinary skilled in the art would categorize and or recognize, the computer as a "general purpose device" and the other exemplary devices "dedicated devices" it is unusual to include a computer in the list of devices such as light switches, televisions, door locks, telephones, coffee makers, security systems and VCRs. Hence, according to Appellant, Madany is characterized as an *unsupported or erroneous reference.*

In response to the above-mentioned interpretation, Appellant's interpretation is noted, however, the reference reads what it reads. Madany does not define the computers of Figures 1 and 7, as a *"general purpose device"*, as argued by Appellant. According to Madany, "Computers 10 and 12 are defined *as any type of computer*, including personal computer or network computer", see column 3, lines 35-40.

"The computers may have different computer architectures base on different microprocessor, see column 8, lines 4-10. "The device may be anything containing sufficient hardware operation and software resources to perform the operations described below. Such devices include, but are not limited to, light switches, televisions, radios, door locks, computer, and the like", see column 3, lines 41-46. Each device contains a processor, ROM, etc see column 7, lines 26-43. The Java based applet may execute on any type of computer or any type of processor, the device may continue to be supported by new processors developed in the future, see column 4, lines 34-40.

Arguments that the computers in the Madany reference are "general purpose computers" and the devices are "dedicated devices" are not persuasive given the noted explicit disclosure of the reference.

6.   Appellant argues (p. 10), the Madany reference fails to discuss how a computer would operate as a device and not as a computer or as a device and computer, the reference according to applicant further fails to explain why a "computer-type device" the might be able to perform its own processing would have another computer do the processing for it or have second "Madany device processor" added to it.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *how a computer would operate as a device and not as a computer or as a device and computer*, and why a "computer-type device" the might be able to perform its own processing would have another computer do the processing for it or have second "Madany device processor" added to it) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7.   Appellant argues (p. 11-12), the Madany reference fails to disclose how his "network control logic" is to be integrated into the existing device, where is the "network control logic" replace existing original dedicated logic or vice versa, that is, the network control logic must be in addition to and not in place of the original dedicated logic. Further, according to Appellant, the applied reference fails to discuss the network control logic performing any of the original dedicated functions or vice versa. Furthermore, according to Appellant, the reference fails to discuss economies or synergies achieved by combining or substituting logic or functions.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *how the reference's "network control logic" is to be integrated into the existing device, where is the "network control logic" replace*

existing original dedicated logic or vice versa, where the network control logic performing any of the original dedicated functions or vice versa and where the reference discuss economies or synergies achieved by combining or substituting logic or functions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. The following argument seems to be more directed to the claimed invention, specifically, the claim language or limitations.

8.   Appellant argues (p. 12-12), that in the Madany reference, the device processor (22) is inexpensive and low power, because according to the claims in the reference, the device is unable to execute a program code, this would exclude according to applicant a whole range of possible hardware erroneously equated with the processor, however with respect to the claimed invention, Madany does not teach updating the applet.

In response to the above-mentioned argument, the broadest reasonable interpretation in light of the specification (MPEP §2111) has been given to the claim language, the pertinent claim limitation of claim 44, calls for a file substitution.

Specifically, prior art teaches retrieving from the network device (computer 11 of Fig. 2) a file (called "network device control software program binary file") having software ("called embedded old downloadable unit") for performing a function or operation (called "old service") substituting in the device the file for another file of another function. Nakagawa et. al. teaches steps for updating software, including upon determining that software has been updated, <u>extracting</u> the configuration of software (Si V) currently being used by the user (user computer 11 of Fig. 2), and returns a method of <u>updating</u> the software at user-site and the software itself required for the <u>update</u> if the software has been updated, <u>replaces</u> the old version according to the update instruction information, etc. in the answer message with the newly stored version, and compiles and links programs if necessary to set the new version in an executable format (column 22, lines 21-67, "Si V" notation represents software "Si", having a version V, and functions see column 13, line 35-44, software being a typically a downloadable file column 1, lines 46-49).

9.   Appellant argues (p. 13), there is not motivation to update the applet in the Madany reference,

In response to the above-mentioned argument, Appellant's interpretation of the Madany reference is noted. Obviousness can only be established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the teachings of Nakagawa would be readily apparent to one ordinary skilled in the art at the time the invention was made because the Madany reference does open his system to the applicability of new processors developed in the future, thereby at the very least it suggest respective ("future developed") program code(s) to maintain compatibility (e.g. operability, etc.) with the future developed processors on which the codes are to be executed (see Madany, column 4, lines 41-42).

10.   Appellant argues the Beard reference fails to teach retrieving embedded software.

In response to the above-mentioned argument, it is understood that Appellant is entitled to be his/her own lexicographer, given the broadest reasonable interpretation in light of the specification (see MPEP §2111), the pertinent claim limitation of claim 44, describes a file substitution in the network device. The prior art teaches this limitation, broadly interpreted as discussed above on item "8", above taught by the Nakagawa reference.

It is noted that, the claimed term *"network device control software program binary file"* has been interpreted as a software file. Specifically, the claimed term "network device control software program", is not described throughout the specification (see office action mailed 05/01/02). According to appellant's specification the claimed term "network device control software program binary file" *seems* simply refers to a software program in machine or executable form, i.e. a binary file, a downloadable unit is an executable unit exemplified in the invention as an applet (see specs page 9), the unit is embed in the binary file. Broadly interpreted, *"network device control software program binary file"*, is a file comprising software.

Furthermore, pertinent to this limitation, the Beard reference teaches services (libraries) can be embedded in the package for the class (column 5, lines 56-column 6, line 12), wherein libraries are services and functions in compiled form that are utilized by an interpreted byte code program downloaded over the network (see column 2/lines 12-20) and the package are a group of related classes associated with a program code (see column 5/lines 33-55). Other references made of record teach this feature (see Palay) on office action mailed 05/01/02.

(12)   *Conclusion*

The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); Richardson-Vicks, Inc., v. The Upjohn Co., 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and psuedoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness).
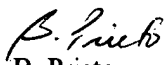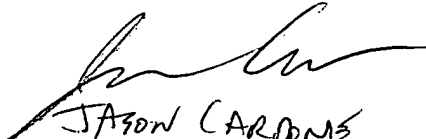
For the reasons above it is believed that the rejection should be maintained.

Respectfully submitted,

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